

REMARKS

Due to the length of the specification herein, Applicants will cite to the paragraph number of the published patent application (PG Pub) of the present application, i.e., US 2006/0100344, when discussing the application description, rather than to page and line of the specification as filed.

The rejection of Claims 1-4 and 11-28 under 35 U.S.C. § 103(a) as unpatentable over US 6,180,876 (Uhrlandt et al), is respectfully traversed.

As recited in Claim 1, an embodiment of the present invention is a precipitated silica, wherein said silica has the following properties:

BET surface area	190 - 302 m ² /g ,
CTAB surface area	≥ 170 m ² /g ,
DBP number	200 - 300 g/(100 g) , and
Sears number V ₂	10-20 ml/ (5 g).

As Applicants have previously stated, the claimed precipitated silica has particular applicability as a tire filler for commercial vehicles, motor bikes, and high-speed vehicles (commercial vehicles). As further noted, silicas used in (normal) automobile tires do not have this capability, as described in the specification at paragraph [0009]. One property which is particularly important for commercial vehicles, i.e., vehicles whose tires are subject to stringent demands in respect of distance performance and/or wear is improved cut & chip and chunking resistance, and bar tear resistance, (all of which are a measure of high-temperature tear resistance), as described in the specification at paragraphs [0033], [0085] and [0086]. The effectiveness of such properties can be measured by the Die C test according to ASTM D 624, wherein the higher the value, the greater the high-temperature tear resistance. In the Declaration under 37 C.F.R. § 1.132 of André Wehmeier, filed June

20, 2008 (first Wehmeier Declaration), Die C for present Example 1 was 75 N/mm, while it was 52 N/mm and 55 N/mm for Examples 4 and 5, respectively, of Uhrlandt et al.

In the present Office Action, the Examiner finds that this data “is irrelevant, because the disclosed precipitated silicas of [Uhrlandt et al] overlap those of the instant invention, [Uhrlandt et al] present a *prima facie* case of obviousness, and a patent’s disclosure is not limited to its examples.”

In reply, the rejection is under 35 U.S.C. § 103(a), not 35 U.S.C. § 102. Thus, overlap of respective ranges, while relevant, is not determinative. Once a *prima facie* case of obviousness is made out, such a case may be overcome by comparing to the closest prior art. The newly-submitted second Wehmeier Declaration declares that the closest prior art to the presently-claimed invention in Uhrlandt et al is Example 4 therein. Applicants have clearly shown in the first Wehmeier Declaration that an embodiment of the present invention, i.e., Example 1, has superior high-temperature tear resistance to Example 4 (and Example 5) of Uhrlandt et al. In addition, the newly-submitted second Wehmeier Declaration shows two additional examples within the terms of the present claims, i.e., Examples 1A and 1B, which together with the data in the first Wehmeier Declaration, establishes a trend that by operating within the full scope of the present invention, superior high-temperature tear resistance to Uhrlandt et al is established. Compare *In re Kollman*, 595 F.2d 48, 56, 201 USPQ 193, 199 (CCPA 1979) (**copy enclosed**).

For all the above reasons, it is respectfully requested that the rejection over Uhrlandt et al be withdrawn.

The rejection of Claims 1, 2, 4 and 21-25 under 35 U.S.C. § 103(a) as unpatentable over US 5,705,137 (Goerl et al), is respectfully traversed.

As Wehmeier declares in the second Wehmeier Declaration, Example 4 of Uhrlandt et al is the closest prior art. Indeed, the silicas of Uhrlandt et al are closer to the presently-

claimed silicas, as can be easily ascertained by simply comparing the Sears numbers of Uhrlandt et al, which broadly encompass the Sears number range of the present claims, and Goerl et al, whose Sears number range of 20-30 only incidentally touches the presently-recited maximum of 20, and the examples and therefore preferred embodiments of, Goerl et al all have Sears numbers greater than 20. Thus, to the extent Applicants have demonstrated unexpected results over Uhrlandt et al, such results can be extrapolated to the less pertinent prior art of Goerl et al. Compare *Ex parte Humber*, 217 USPQ 265 (Bd. Pat. App. & Inter. 1981) (**copy enclosed**) (comparative data showing the claimed chlorine-containing compounds to be unexpected over various (non-prior art) chlorine-containing isomers was accepted as more probative over prior art, drawn to non-chlorine containing analogs of the claimed compounds, asserted to be closest.)

Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 1, 2 and 21-25 under 35 U.S.C. § 103(a) as unpatentable over U.S. 2003/0003040 (Lindner et al), is respectfully traversed.

As stated above with regard to the rejection over Goerl et al, Wehmeier declares in the second Wehmeier Declaration, Example 4 of Uhrlandt et al is the closest prior art. Indeed, the silicas of Uhrlandt et al are closer to the presently-claimed silicas, as can be easily ascertained by simply comparing the Sears numbers of Uhrlandt et al, which broadly encompass the Sears number range of the present claims, and Lindner et al, whose Sears number is greater than 20, preferably greater than 25, and particular preference greater than 28 [0028]-[0033]. Thus, to the extent Applicants have demonstrated unexpected results over Uhrlandt et al, such results can be extrapolated to the less pertinent prior art of Lindner et al. Compare *Ex parte Humber, supra*. Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 1-4 on the ground of non-statutory obviousness-type double patenting over Claims 1 and 13 of Uhrlandt et al, is respectfully traversed. These claims of Uhrlandt et al are no more relevant than the disclosure in Uhrlandt et al, discussed above. Thus, the arguments in traversal of the rejection over Uhrlandt et al as prior art is hereby incorporated by reference. Accordingly, it is respectfully requested that this rejection be withdrawn.

All of the presently-active claims in this application are now believed to be in immediate condition for allowance. The Examiner is respectfully requested to rejoin non-elected process claims 5-13. In addition, the remaining non-elected claims all depend on Claim 1. Accordingly, the Examiner is respectfully requested to pass this application to issue with all pending claims.

Respectfully submitted,

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